

- A*
- B*
- a. receiving an advertisement topic selection from the computer; and
  - b. sending to the computer an advertisement related to the topic selection.

### REMARKS

The Examiner has rejected claims 1-47 under 35 U.S.C. § 103 as being unpatentable over U.S. Pat. No. 5,715,314 to Payne et al. (“Payne”) in view of U.S. Pat. No. 5,105,184 to Pirani et al. (“Pirani”).

The Applicants traverse every statement of Official Notice made by the Examiner in the Office Action. The Applicants respectfully solicit documentary proof of every statement of Official Notice made by the Examiner in the Office Action, in accordance with MPEP section 2144.03.

#### **Claim 1 is Patentable over Payne in View of Pirani**

The Examiner has rejected claim 1 as being unpatentable over Payne in view of Pirani. Claim 1 has been amended only to more particularly point out and distinctly claim subject matter that the Applicants regards as their invention. Claim 1 has not been amended to overcome any of the prior art cited by the Examiner.

The Examiner states that Payne teaches “a client computer having a browser, said client computer connected to said network (col. 3, lines 22-25)...” This section of Payne states, “The client computer and the server computers are interconnected by a computer network. At least one of the server computers is programmed to record purchase transaction records in a database.” Payne, col. 3, lines 22-25. This section, nor any other section of Payne or Pirani discloses a browser. As defined by the Applicants, a browser is software “which resides on the user’s client computer” (Application at 2, lines 21-22) and is used to view “pages at a site” (Application at 2, lines 20-21). A “site” is a “logical grouping of hypertext files (Application at 2, lines 7-8).

Payne describes a system where a buyer computer requests an “advertising document” from a merchant computer using a Universal Resource Locator (URL), whereupon the merchant computer sends the requested “advertising document” to the buyer computer. Payne col. 5, lines 15-25. The user “browses through the advertising document and eventually requests a product.” Payne col. 5, lines 26-27. If the Examiner maintains that Payne discloses a browser functionally, the Payne teaches away from the Applicants’ invention. The

Applicants do not claim a system wherein advertisements are retrieved and displayed by a client computer using a browser. Rather, the Applicants claim a system wherein a special purpose piece of software besides the browser retrieves and displays an advertisement. The most generous reading of Payne discloses a system wherein the browser itself retrieves and displays an “advertising document.” Payne, col. 5, lines 15-27. As the Examiner states, Payne “fails to teach an advertising software on said client computer...said advertising software displaying said advertisements ...on said client computer while maintaining the functionality of said browser.” Office Action at 3.

The Examiner states that Pirani “teaches a system of using advertising software (col. 4, lines 62-68, col. 2, lines 39-42).” Office Action at 3. The first of these sections states, “1. Integration of one letter to a whole screen advertisement with various screens (data entry, menu, edit, etc.) of a software. 2. Displaying advertisement of one letter to a whole screen page integrated with a software in which a sequence of display screens are divided between advertisements and the software.” Pirani col. 4, lines 62-68. The terms “integration of one letter” and “advertisement of one letter” are unclear to the Applicants as they have no ordinary meaning and are not defined in Pirani. This section is not enabling, and hence not valid prior art to the Applicants’ invention. The Applicants earnestly solicit the Examiner’s more detailed views regarding the exact nature of what is disclosed by this section of Pirani.

The second of these sections states “It is also an object of this new use to provide sequence of displays to integrate advertisements with software. It is another object of this new use to provide directory advertisements integrated with software.” Pirani col. 2, lines 39-42. These statements are merely objectives and are not enabling. Because they represent only aspirations and disclose nothing about Pirani’s invention, they are not valid prior art to the Applicants’ invention. It may be instructive that Pirani’s only claim was canceled as the result of a reexamination by the Patent Office. Reexamination Certificate B1 5,105,185.

Even if the cited sections of Pirani were valid prior art, they teach away from the Applicants’ invention. Pirani discusses a system that integrates advertising into different screens generated by computer software. See, e.g., Pirani, claim 1 and col. 2, lines 26-29. The Applicants’ invention purposely keeps advertising separate from the operation of the browser at the client. While Pirani discusses integration, the Applicants’ invention claims separating advertising.

The Examiner states Pirani includes some motivation to combine what is disclosed by Pirani with the invention disclosed by Payne to obtain the Applicants' invention. On the contrary, Pirani teaches away from the Applicants' invention, and includes no such motivation. Pirani distinguishes its "invention" from a system of sending advertisements to a client over a network. "Prodigy is an online services while "Masonry Estimating Software" does not require a telephone or a modem." Pirani col. 1, lines 57-59. Distributing advertisements over a network is essential to the Applicants' invention. Also, Pirani makes clear that it seeks to integrate advertising into software whose primary purpose is not advertising, distinguishing itself from software whose primary purpose is advertising. "Some computer software provide identification of products by using the products as part of the software. Pirani col. 1, lines 35-36. "But the product identification is not distinct from the software itself." Pirani, col. 1. lines 40-41. The element of the Applicants' invention that controls the display of advertising is software dedicated to advertising. These features and others of Pirani teach away from the Applicants' invention.

Amended claim 1 includes elements that are not disclosed by Payne nor by Pirani. Amended claim 1 includes a browser and advertising software, each of which controls the display of information on different regions of the display device. The advertising software (not the browser) receives an advertisement from the server. The advertising software functions substantially independently of the browser. None of these features are disclosed by either Payne or Pirani. Thus, even if the cited references were combined, they would not result in the invention of amended claim 1.

Further, neither Payne nor Pirani include a suggestion to combine the features disclosed in these references. Payne is directed to a networked system, while Pirani teaches away from a networked system, as described above. Payne discloses a system wherein advertisements are retrieved and displayed by a monolithic piece of software, not a piece of software specially adapted to handle advertisements operating at the same time on the same platform as another piece of software not necessarily specially adapted to handle advertisements. There is no suggestion in Payne or Pirani towards the two-component system claimed by the Applicants. On the contrary, Pirani teaches away from a two-component system by preaching the integration of advertising into a piece of software designed principally for a purpose other than advertising.

For at least the foregoing reasons, claim 1 is patentable over Payne in view of Pirani.

**Claims 2-12 are Patentable over Payne in View of Pirani**

The Examiner has rejected claims 2-12 as being unpatentable over Payne in view of Pirani. Claims 2, 4-6, 8, 9, 11 and 12 have been amended only to more particularly point out and distinctly claim subject matter that the Applicants regard as their invention. These claims have not been amended to overcome any of the prior art cited by the Examiner.

Claims 2-12 are patentable over Payne in view of Pirani because they depend from claim 1, which is patentable over Payne in view of Pirani.

Further, each of claims 2-8 and 10-12 include at least one limitation that is not disclosed in either Payne or Pirani: a media clip (amended claim 2); a secure purchase (claim 3); a communications button for establishing communications with a sales agent (amended claim 4); means for selecting advertising topics (amended claim 5); a help page (amended claim 6); an advertisement service home page (claim 7); a link that loads a page in a the separate area of the display controlled by the browser (amended claim 8); an electronic coupon (claim 10); means for displaying a previously displayed advertisement (amended claim 11); and means to pause a sequence of advertisements being shown to the user (amended claim 12). Thus, even if the two cited references were combined, the claimed invention would not result.

For at least the foregoing reasons, claims 2-12 are patentable over Payne in view of Pirani.

**Claim 13 is Patentable over Payne in View of Pirani**

The Examiner has rejected claim 13 as being unpatentable over Payne in view of Pirani. Claim 13 has been amended only to more particularly point out and distinctly claim subject matter that the Applicants regard as their invention. Claim 13 has not been amended to overcome any of the prior art cited by the Examiner.

The Applicants repeat the arguments set forth above pertaining to the patentability of those features of the Applicants' invention claimed in claim 13 that are also claimed in one or more of claims 1-12.

The Examiner again cites Pirani (col. 4, lines 62-68, col. 2, lines 39-42) as motivation to combine the disclosure of Pirani with that of Payne to obtain the present invention. Office Action at 7. For the reasons set forth above, neither the cited sections of Pirani nor any other

parts of Pirani or Payne include any suggestion or motivation to combine the inventions disclosed in both references to obtain the Applicants' invention. On the contrary, Pirani teaches away from the invention of claim 13 for the reasons stated above.

Claim 13 includes elements that are not disclosed in either Payne or Pirani. Even if these references were combined, they would not result in the invention of claim 13. In particular, neither Payne nor Pirani disclose a browser and advertising software operating as two elements on a platform (the client computer). Neither discloses or suggests an advertising area with controls that allow the user to pause the display of a sequence of advertisements; or a step back button and step forward button by which the user can control the display of advertisements. These advantageous features of the present invention are entirely missing from the two cited references.

The Examiner concedes that Payne "specifically fails to teach a system wherein a control area having a pause button, a step back button, a display area, and a step forward presentation of advertisements controlled by a user." Office Action at 8. "However, it is obvious to pause, step fast forward, and bring back a page of a displayed advertisement. It would have been obvious to a person of ordinary skill in the art at the time the invention was made to use this technique. One would have been motivated to use these techniques because a skilled artisan would recognize that this motivation would provide Payne et al. with the capability to provide more options to users to be accustomed with an advertised item." Office Action at 8. The Examiner does not provide any support for this statement from either reference, and has therefore failed to establish a *prima facie* case of obviousness.

Claim 13 is patentable over Payne in view of Pirani because claim 13 includes elements that are not disclosed by either reference. Furthermore, neither reference includes any suggestion or motivation to combine the features disclosed therein to create the invention of claim 13.

For at least the foregoing reasons, claim 13 is patentable over Payne in view of Pirani.

#### **Claims 14-21 are Patentable over Payne in View of Pirani**

The Examiner has rejected claims 14-21 as being unpatentable over Payne in view of Pirani. Claims 14-21 have been amended only to more particularly point out and distinctly

claim subject matter that the Applicants regards as their invention. These claims have not been amended to overcome any of the prior art cited by the Examiner.

Claims 14-21 are patentable over Payne in view of Pirani because claim 14-21 depend from claim 13, which is patentable over Payne in view of Pirani.

Further, each of claims 14-21 includes at least one limitation that is not disclosed by either Payne or Pirani. Thus, even if Payne and Pirani were combined, the invention claimed in claims 14-21 would not result.

In particular, neither Payne nor Pirani disclose a communications button for establishing communications with a sales agent (claim 14); a help button in the advertising area that, when selected by the user, causes a help page to be displayed in the browser area (claim 15); a multimedia button in the advertising area that, when selected by the user, causes multimedia information to be displayed in the browser area (claim 16); a home page button in the advertising area that, when selected by the user, causes a home page to be displayed in the browser area (claim 17); an advertising topic list shown in the advertising area with topics selectable by the user to control the advertisements shown in the advertising area (claim 18); an advertisement in the advertisement area that includes a link that, when selected, loads and displays a page in the browser area (claim 19); a server that targets advertisements to the user related to the pages viewed by the user through the browser (claim 20); and an electronic coupon (claim 21). Nor does Payne or Pirani suggest any of these elements.

The Applicants respectfully disagree with the Examiner's position that "Official notice is taken that it is old and well known in the data processing art that most advertisement servers comprise of a help page for the purpose of helping a user navigate through the advertising system." See. e.g, Office Action at 9 and 10. The Applicants maintain that it is not old nor well known in the art to provide a help page on an advertisement server. Nor, in accordance with the correct standard, was it old nor well known at the time Applicants' invention was made. Rather, known advertising servers sent advertisements only at the time the Applicants' invention was made, and did not provide a help page.

The Applicants also disagree with the Examiner's position that "Official notice is taken that it is old and well known in the data processing art to use a link to improve the communication operation to display a page of an advertisement." Office Action at 10. Again, this is the incorrect standard. See 35 U.S.C. § 103(a)(prior art must be considered at the time

the invention was made). At the time the Applicants' invention was made, it was not "old and well known in the data processing art to use a link to improve the communication operation to display a page of an advertisement." Even if such were the case, claims 19 would still be patentable, because it was not known to display an advertisement in an advertising area that, when selected by the user, loads and displays a page in a browser area, where the advertising area and the browser are controlled by two substantially independent pieces of software.

For at least the foregoing reasons, claims 14-21 are patentable over Payne in view of Pirani.

**Claim 22 is Patentable over Payne in View of Pirani**

The Examiner has rejected claim 22 as being unpatentable over Payne in view of Pirani. Claim 13 has been amended only to more particularly point out and distinctly claim subject matter that the Applicants regards as their invention. Claim 22 has not been amended to overcome any of the prior art cited by the Examiner.

The Examiner states that Payne teaches a method for streaming a sequence of advertisements from a server to a client. Col. 2, lines 39-42. Office Action at 11. This section of Payne states "the plurality of products added to the shopping cart and to cause the payment message to be activated to initiate a payment transaction for the plurality of products added to the shopping cart." Payne, col. 2, lines 39-42. This section does not disclose a method for streaming advertisements, but rather discloses some elements of a purchase transaction. Neither advertisements or streaming are mentioned. The streaming element of claim 22 is not disclosed or suggested by Payne. Nor is it disclosed or suggested by Pirani.

The Examiner states that Payne discloses displaying said advertisements to the user in said advertising area while maintaining the functionality of the browser in the browser area at col. 9, lines 41-47. Office Action at 11. This section of Payne states "A user may request display of a product included in the smart statement. When the user requests that the product be displayed (step 166), the buyer computer sends the access URL contained in the smart statement document to the merchant computer (step 168), and the buyer computer and merchant computer perform a set of steps analogous to steps 94-104 in FIG 2 (authentication of access URL, verification whether duration time has expired, verification of buyer network address, and transmission of fulfillment document to buyer computer)." Payne, col. 9, lines 41-47. This section does not disclose or suggest the use of two pieces of software, a browser

and advertising software, nor how two such pieces operate (e.g., in a way to maintain the functionality of the browser.) Amended claim 22 makes it clear that the advertisements are streamed to the advertising software and displayed substantially independently of the operation of the browser. None of these features are disclosed in the cited references.

The Examiner states that Pirani "teaches a method of using advertising software in advertising" as evidence of motivation to use the techniques of Pirani with the features disclosed by Payne. Office Action at 11. The Applicants respectfully submit that the idea of "using advertising software in advertising" does not provide any motivation to combine the references to obtain the invention of claim 22. Indeed, for the reasons described above, both references fail to disclose numerous limitations of claim 22, and so could not result in the invention of claim 22 even if they were combined.

For at least the foregoing reasons, claim 22 is patentable over Payne in view of Pirani.

**Claims 23-34 are Patentable over Payne in View of Pirani**

The Examiner has rejected claims 23-34 as being unpatentable over Payne in view of Pirani. Claims 23-34 have been amended only to more particularly point out and distinctly claim subject matter that the Applicants regards as their invention. These claims have not been amended to overcome any of the prior art cited by the Examiner.

Claims 23-34 are patentable over Payne in view of Pirani because these claims depend from claim 22, which is patentable over Payne in view of Pirani.

Further, each of claims 23-34 include at least one limitation that is not disclosed by either Payne or Pirani. Thus, even if these references were combined, the invention claimed in claims 23-34 would not result.

In particular, neither Payne nor Pirani disclose or suggest the step of pausing the display of advertisements at the request of the user (claim 23); steps of caching a predetermined number of advertisements on the client computer, pausing the display of the sequence of advertisements and stepping backward and forward through and displaying the cached advertisements to the user at the user's request (claim 24); the step of immediately displaying the next advertisement in the advertisement area at the user's request (claim 25); the step of effectuating a secure purchase of an item shown in the presently displayed advertisement at the user's request (claim 26); the step of establishing communications between the user and a sales agent representing the sponsor of the presently displayed

advertisement at the user's request (claim 27); the step of showing to the user multimedia information pertaining to the presently displayed advertisement at the user's request (claim 28); the step of showing an advertising service home page to the user at the user's request (claim 29); the step of showing an advertising service help page to the user at the user's request (claim 30); the steps of displaying a list of advertising topics to a user and displaying advertisements in the advertisement area pertaining to the advertising topics selected by the user (claim 31); the step of displaying an advertiser page in the browser area when the advertisement shown in the advertising area is selected by a user (claim 32); the steps of determining the topics of pages viewed through a browser on a client computer at the user's request, selecting advertisements related to the topics, and transmitting the advertisements related to the topics to the client computer (claim 33); and the steps of storing an electronic coupon when selected by the user, and redeeming the electronic coupon during a secure purchase transaction at the request of the user.

The examiner's objection to each of claims 23-34 are supported only by one or more general statements to the effect that it would have been obvious for one of ordinary skill in the art to modify the invention disclosed in Payne based upon the disclosure of Pirani. Office Action at 11-15. None of these statements are supported by a citation to a particular part of either Payne or Pirani. As such, they are insufficient to establish a *prima facie* case of obviousness with respect to claims 23-34. In certain of these general statements, the Examiner takes Official Notice of certain situations. The Applicants traverse each statement of Official Notice made by the Examiner with respect to claims 23-34, and respectfully asks the Examiner to provide documentary proof of every such statement, in accordance with MPEP 2144.03.

For at least the foregoing reasons, claims 23-34 are patentable over Payne in view of Pirani.

**Claims 35-36 are Patentable over Payne in View of Pirani**

The Examiner has rejected claim 35 as being unpatentable over Payne in view of Pirani. Claim 35 is patentable over Payne in view of Pirani because claim 35 contains at least one limitation that is neither disclosed nor suggested in either Payne or Pirani.

The Examiner states that Payne discloses "accepting a secure purchase request from a user for the item offered in a presently displayed advertisement" at col. 3, lines 24-34. This

section of Payne discloses that “the client computer is programmed to display the product descriptions, to receive a request from the client user to display a product corresponding to a product description displayed by the client computer, and to cause a product hypertext link derived from a purchase transaction record to be activated.” Payne, col. 3, lines 29-34. This does not disclose accepting a secure purchase request from a user for the item offered in a presently displayed advertisement. Application, claim 35. Payne does not disclose or suggest the possibility of being able to accept a secure purchase request from the user while at the same time displaying to the user an advertisement for the item being purchased. Nor does Pirani disclose or suggest this limitation.

The Applicants respectfully maintain that the other limitations of claim 35 are neither disclosed nor suggested by either Payne or Pirani. In particular, neither Payne nor Pirani disclose or suggest loading advertising software from a server to a client computer that has a separate browser; dividing the client computer screen into a browser area and an advertisement area; streaming a sequence of advertisements from the server to the client; and displaying the advertisements to the user in the advertisement area while maintaining the original functionality of the browser in the browser area. The sections of the references cited by the Examiner have been discussed above (Payne, col. 9, lines 41-47, col 13, lines 24-34) for similar limitations of other claims. The arguments for patentability presented above in relation to these sections of Payne are hereby repeated by reference in support of the patentability of claim 35.

The Examiner has also rejected claim 36. Claim 36 is patentable over Payne in view of Pirani because claim 36 depends from claim 35, which is patentable over Payne in view of Pirani.

#### **Claims 37-39 are Patentable over Payne in View of Pirani**

The Examiner has rejected claims 37-40 as being unpatentable over Payne in view of Pirani. Claims 27-39 have been amended. Claim 40 has been canceled.

Claim 37 is patentable over Payne in view of Pirani because neither Payne nor Pirani disclose or suggest an electronic coupon, and in particular do not disclose or suggest the use of an electronic coupon in conjunction with an advertisement as claimed in amended claim 37. The Examiner states that Payne “specifically fails to teach a method of storing an electronic coupon when said advertisement is selected by a user, and redeeming said coupon

during a secure purchase transaction at the request of a user.” Office Action at 17. “However, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to use this technique with Payne et al.’s teachings. One would have been motivated to use this technique with Payne et al.’s teachings because it would provide Payne et al. with the capability to encourage a user into consuming an advertisement when making purchase transactions.” These statements are made without any support from any reference, and therefore fail to establish a *prima facie* case of unpatentability for claim 37 (as amended). Indeed, the Examiner appears to argue that limitations of claim 37 are obvious because they are useful. Were that the law, nothing would be patentable. Indeed, usefulness is a condition, not a bar, to patentability. 35 U.S.C. § 101 (“whoever invents or discovers and new and useful process...or any new and useful improvement thereof, may obtain a patent therefore...”) The Examiner has cited no prior art reference with these limitations. Hence, claim 37, as amended, is patentable over Payne in view of Pirani.

Claims 38 and 39 are patentable over Payne in view of Pirani because claims 38 and 39 depend from claim 37, which is patentable over Payne in view of Pirani.

**Claims 41 and 42 are Patentable over Payne in View of Pirani**

The Examiner has rejected claims 41 and 42 as being unpatentable over Payne in View of Pirani. The arguments made for the patentability of those limitations of claim 35 that are shared with claim 41 are hereby repeated by reference. The Examiner states that Payne discloses forwarding preregistered purchaser information to the sponsor of a presently displayed advertisement if the confidential authentication password provided by the user matches a confidential authentication password stored on the server, and generating an error message if the password provided by the user does not match the password stored on the server at Payne, col. 6, lines 25-29, col. 8, lines 3-8. The cited sections of Payne do not disclose forwarding preregistered purchaser information to the sponsor of an advertisement presently displayed to a user if the user is properly authenticated. Rather, the cited sections of Payne disclose sending user payment information to a payment computer (col. 6, lines 25-29) and permitting or denying a user access to a “network sales system” based upon the authentication of a request from the user to add a product to an electronic “shopping cart” (col. 7, lines 55-67, col. 8, lines 1-14.) Likewise, Pirani contains no such disclosure or suggestion. Claim 41 is therefore patentable over Payne in view of Pirani.

Claim 42 is patentable over Payne in view of Pirani because it depends from claim 41, which is patentable over Payne in view of Pirani.

**Claims 45 and 47 are Patentable over Payne in View of Pirani**

Claim 45 as amended incorporates the limitations of claim 46, which is canceled.

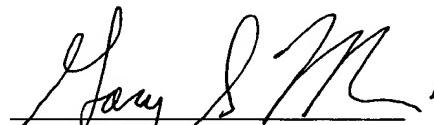
Claims 45 as amended to include limitations that are neither disclosed nor suggested by Payne or Pirani, and hence is patentable over Payne and Pirani. In particular, claim 45 includes limitations means for identifying the topics of pages displayed by the client, and means for selecting advertisements corresponding to said topics.

Claim 47 is patentable over Payne in view of Pirani because claim 47 depends from claim 45, which is patentable over Payne in view of Pirani.

**CONCLUSION**

In view of the foregoing remarks, the Applicants respectfully request that the Examiner reconsider and withdraw all outstanding grounds of rejection. A Notice of Allowance is earnestly solicited.

Respectfully submitted,

  
\_\_\_\_\_  
Gary S. Morris  
Reg. No. 40,735

Date: November 18, 1998  
KENYON & KENYON  
1025 Connecticut Ave., NW  
Washington, DC 20036  
Tel: (202) 429-1776  
Fax: (202) 429-0796